

### **REMARKS**

Claims 1-25 are pending in the present application. None of the claims have been amended in this response.

Claims 1-25 were rejected under 35 U.S.C. §112, first paragraph as containing subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and or use the invention. Applicant respectfully traverses the rejection.

Before any analysis of enablement can occur, it is necessary for the examiner to construe the claims. For terms that are not well-known in the art, or for terms that could have more than one meaning, it is necessary that the examiner select the definition that he/she intends to use when examining the application, based on his/her understanding of what applicant intends it to mean, and explicitly set forth the meaning of the term and the scope of the claim when writing an Office Action. *See Genentech v. Wellcome Foundation*, 29 F.3d 1555, 1563-64, 31 USPQ2d 1161, 1167-68 (Fed. Cir. 1994) (MPEP 2164.04).

In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. (MPEP 2164.04).

The Office Action fails to meet this burden, and instead poses a series of questions that are readily answerable from the disclosure. For instance, one example of “control information” and the type of communication is identified in the specification in the last paragraph of page 14 to the first paragraph of page 16, the first full paragraph of page 17, and the disclosure in FIG. 8. One example of purchase/service information is discussed in FIG. 3, and related text. If there are issues of enablement, the Examiner is required to specifically point out the reasons why one

skilled in the art would not be able to practice the invention. However, no particular analysis has been brought forth to explain why the claims in the present application are not enabled. Accordingly, the Applicant submits that the rejection under 35 U.S.C. §112(1) is improper and should be withdrawn.

Claims 1-11 and 13-21 and 23-25 were rejected under 35 U.S.C. §102(e) as being anticipated by *Black* (US Patent 5,910,776). Claims 12 and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Black* (US Patent 5,910,776) in view of *Clare* (US Patent No 5,745,036). Applicant traverses these rejections. Favorable reconsideration is respectfully requested.

Specifically, none of the cited art, alone or in combination, discloses “control-information acquiring means for acquiring, from said electronic apparatus, control information used for writing or reading product history information which includes at least one of purchase information and repair information concerning said electronic apparatus” and “product-history updating means for updating the product history information stored in said electronic apparatus based on the control information stored in said control-information identification/storage means” as recited in claim 1, and similarly in claims 14-16, 24 and 25.

*Black* discloses a system and method for identifying, locating and monitoring equipment via RFID interface placed in an electrical outlet (col. 3, lines 60-65). *Black* is completely silent with regard to acquiring purchase information and repair information, and also does not teach updating the product history information. Instead, *Black* merely teaches the monitoring of devices with regard to whether or not they are plugged into an electrical receptacle having an RFID reader (col. 4, line 59 to col. 5, line 4). Accordingly, Applicant respectfully submits that the rejection is improper and should be withdrawn.

The *Clare* reference teaches a transaction record 36 that is generated at a POS register via RFID, where the record 36 is forwarded to a remote computer or inventory terminal for tracking and providing security for products purchased in a store (col. 6, lines 1-17). While the RFID tags provide date of purchase, *Clare* is silent with respect to repair information. Furthermore, there is no teaching, suggestion or motivation to combine the teaching of *Clare* with that of *Black*. As discussed above, *Black* is configured to monitor devices that are plugged into electronic receptacles equipped with RFID readers. There is no reason one of ordinary skill in

the art would be motivated to rely on the POS configuration disclosed in *Clare*, as no purchasing is even mentioned in the disclosure of *Black*. Accordingly the rejection under 35 U.S.C. §103 is improper and should be withdrawn.

Furthermore, claims 1 and 16 recite features that are in means-plus-function format. The "broadest reasonable interpretation" that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. 35 U.S.C. 112, sixth paragraph states that a claim limitation expressed in means-plus-function language "shall be construed to cover the corresponding structure described in the specification and equivalents thereof." Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination (see MPEP 2181).

In light of the above amendments and arguments, Applicant submits that the present claims are allowable over the prior art. Applicant also requests that a timely Notice of Allowance be issued in this case. Should there be any charges regarding this application, the Examiner is hereby authorized to charge Deposit Account 02-1818 for any insufficiency of payment.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY 

Peter Zura

Reg. No. 48,196

P.O. Box 1135

Chicago, Illinois 60690-1135

Phone: (312) 807-4208

Dated: January 4, 2005